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Paper No. None

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**COPY MAILED**

JUL 20 2004

**OFFICE OF PETITIONS**

In re Application of :  
Jack V. Smith :  
Application No. 09/829,563 :  
Filed: April 11, 2001 :  
Title: METHOD FOR ASSAYING :  
BIOLOGICAL AND OTHER :  
CONSTITUENTS USING SYNTHETIC :  
NUCLEOUNITS IN LATERAL FLOW, :  
LIQUID, AND DRY CHEMISTRY :  
TECHNIQUES :  
:

DECISION ON PETITION UNDER  
37 C.F.R. §§1.137(A)

This is a decision on the petition filed May 4, 2004, pursuant to 37 C.F.R. §§1.137(a)<sup>1</sup> to revive the above-identified application.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed August 29, 2002, which set a shortened statutory period for reply of three (3) months. On February 5, 2003 a response was received, along with a two-month extension of time (the amendment contained a certificate of mailing dated January 29, 2003). It was determined that the amendment was non-responsive, and on May 2, 2003, the Office mailed a communication which informed the Applicant that he was given one month to submit a responsive amendment. On June 2, 2003 a second amendment was received, and again it was determined that this amendment was non-responsive. On September 23, 2003, the Office mailed

<sup>1</sup> A grantable petition pursuant to 37 CFR §1.137(a) must be accompanied by:

- (1) the required reply (in a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof);
- (2) the petition fee;
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and;
- (4) a terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to paragraph (d) of this section.

a communication which informed the Applicant that he was given one month to submit a responsive amendment. On October 23, 2003 a third amendment was received. On January 14, 2004, the Applicant was sent a communication which stated that the third amendment was non-responsive and appeared to be a non-bona-fide response. The communication set forth that the application would go abandoned after the expiration of the time period set forth in the mailing of September 23, 2003. On January 22, 2004, a Request for Continued Examination (RCE) was received, and on February 5, 2004, a communication was mailed to the Applicant which explained that the RCE would not be entered, as it was improperly submitted prior to the closure of prosecution. As such, the application went abandoned on October 24, 2003. A Notice of Abandonment was mailed April 16, 2004.

With the instant petition, Petitioner has supplied the fee associated with the filing of a petition under 37 C.F.R. §1.137(a) and a statement of facts.

Petitioner has further requested that the fee associated with the filing of an RCE be refunded, as well as "the proper documentation to file a formal complaint with regards to this application."

Regarding the fee associated with the filing of an RCE, Petitioner is entitled to have the \$385 refunded to him. It is recommended that he submit a request for refund to the Office of Finance<sup>2</sup>. A copy of this decision should accompany any such request.

Regarding the filing of a formal complaint, normally it is recommended that Applicants contact the Supervisory Patent Examiner who manages the Examiner in charge of the application. It is noted that the Petitioner has stated that he has already taken this action.

Regarding the petition under 37 C.F.R. §1.137(a), Petition has met requirement (2) above. Requirement (4) does not apply.

Regarding the first requirement, the requirement has not been satisfied because Petitioner did not submit the required reply to the Office action. The required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed<sup>3</sup>. In order for the application to be revived, petitioner must submit a reply which satisfies 37 C.F.R. §1.137(a)(1) (i.e., either an amendment or a request for reconsideration which is fully responsive, or the filing of a continuing application). The petition was not accompanied by any of these replies. Although the Petitioner filed an RCE, the RCE was improper has prosecution on the merits had not closed.

Regarding the third requirement above, the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR §1.137(a).

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<sup>2</sup> The Refund Branch processes all customer requests for refunds. It generally takes four to six weeks for a request to be processed and a check generated. All requests for refund should be sent to: Mail Stop 16, Director of the US Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450. Office hours are Monday - Friday from 8:30 AM to 5:00 PM. To check the status of a request that has been filed please contact the Refund Branch directly at 703-305-4229.

<sup>3</sup> See M.P.E.P. 711.03(c).

**The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard**

35 USC §133 states, “Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.” (emphasis added)

“In the specialized field of patent law, … the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. His interpretation of those provisions is entitled to considerable deference.”<sup>4</sup>

**The standard**

“[T]he question of whether an applicant’s delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account.”<sup>5</sup>

The general question asked by the Office is: “Did petitioner act as a reasonable and prudent person in relation to his most important business?”<sup>6</sup>

Nonawareness of a PTO rule will not constitute unavoidable delay.<sup>7</sup>

The burden of showing the cause of the delay is on the person seeking to revive the application<sup>8</sup>.

A delay caused by an applicant’s lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered “unavoidable” due to either the applicant’s

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4 Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA)1876 (D.D.C. 1990), aff’d without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) (“an agency’ interpretation of a statute it administers is entitled to deference”); see also Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) (“if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency’s answer is based on a permissible construction of the statute.””

5 Id.

6 See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

7 See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel’s nonawareness of PTO rules does not constitute “unavoidable” delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

8 Id.

reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action.

### **The regulations and portion of the MPEP relevant to the abandonment of this application**

#### 37 C.F.R. § 1.2: Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

#### 37 C.F.R. § 1.111: Reply by applicant or patent owner to a non-final Office action.

(a)

(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

(2) A second (or subsequent) supplemental reply will be entered unless disapproved by the Commissioner. A second (or subsequent) supplemental reply may be disapproved if the second (or subsequent) supplemental reply unduly interferes with an Office action being prepared in response to the previous reply. Factors that will be considered in disapproving a second (or subsequent) supplemental reply include:

(i) The state of preparation of an Office action responsive to the previous reply as of the date of receipt (§ 1.6) of the second (or subsequent) supplemental reply by the Office; and  
(ii) The nature of any changes to the specification or claims that would result from entry of the second (or subsequent) supplemental reply.

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

[46 FR 29182, May 29, 1981; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

#### 37 C.F.R. § 1.112: Reconsideration before final action.

After reply by applicant or patent owner (§ 1.111 or § 1.945) to a non-final action and any comments by an inter partes reexamination requester (§ 1.947), the application or the patent under reexamination will be reconsidered and again examined. The applicant, or in the case of a reexamination proceeding the patent owner and any third party requester, will be notified if claims are rejected, objections or requirements made, or decisions favorable to patentability are made, in the same manner as after the first examination (§ 1.104). Applicant or patent owner may reply to such Office action in the same manner provided in § 1.111 or § 1.945, with or without amendment, unless

<sup>9</sup> See *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985).

such Office action indicates that it is made final (§ 1.113) or an appeal (§ 1.191) has been taken (§ 1.116), or in an inter partes reexamination, that it is an action closing prosecution (§ 1.949) or a right of appeal notice (§ 1.953).

[46 FR 29182, May 29, 1981; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

37 C.F.R. § 1.114: Request for continued examination.

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

- (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
- (2) Abandonment of the application; or
- (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.

(d) If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief under § 1.192 or a reply brief under § 1.193(b), or related papers, will not be considered a submission under this section.

(e) The provisions of this section do not apply to:

- (1) A provisional application;
- (2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;
- (3) An international application filed under 35 U.S.C. 363 before June 8, 1995;
- (4) An application for a design patent; or
- (5) A patent under reexamination.

[Added 65 FR 14865, Mar. 20, 2000, effective May 29, 2000; revised 65 FR 50092, Aug. 16, 2000]

37 C.F.R. 1.135: Abandonment for failure to reply within time period.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

[Paras. (a), (b), and (c), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (d) deleted, 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

711.03(c) of the MPEP sets forth, in part:

The required reply to a non-final action in a nonprovisional application abandoned for failure to prosecute may be either:

(A) an argument or an amendment under 37 CFR 1.111;  
(B) the filing of a continuing application under 37 CFR 1.53(b) (or a continued prosecution application (CPA) under 37 CFR 1.53(d) if the application is a utility or plant application filed before May 29, 2000, or a design application). The grant of a petition under 37 CFR 1.137 is not a determination that any reply under 37 CFR 1.111 is complete. Where the proposed reply is to a non-final Office action, the petition may be granted if the reply appears to be bona fide. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect. In this limited situation, the patent examiner should send out a letter giving a 1-month shortened statutory period under 37 CFR 1.135(c) for correction of the error or omission. Extensions of time under 37 CFR 1.136(a) are permitted. If applicant does not correct the omission within the time period set in the letter (including any extension), the application is again abandoned.

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The dismissal or denial of a petition under 37 CFR 1.137(a) does not preclude an applicant from obtaining relief pursuant to 37 CFR 1.137(b) on the basis of unintentional delay (unless the decision dismissing or denying the petition under 37 CFR 1.137(a) indicates otherwise). In such an instance, a petition under 37 CFR 1.137(b) may be filed accompanied by the fee set forth in 37 CFR 1.17(m), the required reply, a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and any terminal disclaimer required by 37 CFR 1.137(c).

### **Application of the standard to the current facts and circumstances**

Unfortunately, petitions filed under 37 C.F.R. §1.137(a) (where the cause of the abandonment is characterized as “unavoidable”) have a very stringent standard associated with them.

With the instant petition, Petitioner has alleged that after having received a non-final Office action and subsequently submitting numerous non-responsive amendments, he was told by a member of the PTO that the application was under final and that either an RCE or a Notice of Appeal would be required to save the application from abandonment.

Petitioner’s arguments have been considered, and they have been deemed to be unpersuasive.

It is noted that the oral advice which was purportedly given to Petitioner contradicts that which was set forth in writing by the Examiner, as the Office action of August 29, 2002 sets forth that the rejection was non-final, and each of the mailings which indicated that the subsequent submissions were non-responsive indicated that a responsive amendment is what was required. It does not appear the filing of either an RCE or an Appeal Brief was suggested in writing.

Obviously, the undersigned was not privy to the discussion the Petitioner purportedly had with the Office employee where it was recommended that he undertake this incorrect action. It is unfortunate that pursuant to both 37 C.F.R. §1.2 and In re Sivertz that a delay caused by reliance on oral advice from PTO employees cannot be viewed as unavoidable.

Had Petitioner addressed the merits of the decision of August 29, 2002 and submitted a responsive amendment, as was explicitly set forth in the mailings of May 2, 2003, September 23, 2003, and January 14, 2004, the application would have not gone abandoned. Ignoring the merits of these three mailings does not appear to evince the treatment of this application as one’s

most important business. As such, it is difficult to characterize the failure to do the same as unavoidable.

Therefore, it is determined that delay was perhaps unintentional, but certainly not unavoidable.

As such, the petition must be **DISMISSED**.

#### **Alternate venue**

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR §1.137(b). A grantable petition pursuant to 37 CFR §1.137(b) must be accompanied by the required reply (already submitted), the required petition fee, and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR §1.137(b) was unintentional. A copy of a blank petition form may be found at <http://www.uspto.gov/web/forms/sb0064.pdf>.

The filing of a petition under 37 CFR §1.137(b) cannot be intentionally delayed, and therefore, must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR §1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR §1.137(b).

#### **Response**

Any reply must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled “Renewed Petition Under 37 C.F.R. §1.137(a) and/or §1.137(b), if applicable.” This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition should display “Please deliver to Paul Shanoski, c/o Office of Petitions” in a prominent manner.

To help assure prompt and proper attention to your response, please see the enclosed Request for Alert Concerning Submitted Petitions, 1282 Official Gazette (May 18, 2004) for further information on how to assist the Office in delivering your submission to the correct location. The Petitioner may wish to consider telephoning the undersigned one month after the submission is made to confirm that the documents were properly delivered.

Any renewed petition may be submitted by mail<sup>10</sup>, hand-delivery<sup>11</sup>, or facsimile<sup>12</sup>.

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<sup>10</sup> Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

<sup>11</sup> Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

<sup>12</sup> (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned.

**The application file will be retained in the Office of Petitions for two (2) months.**

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011.

Please note that on approximately September 28, 2004, the Office of Petitions will relocate to the new PTO location in Alexandria. Although the mailing address will remain the same, the general phone number for the Office of Petitions which should be used for status requests will change to 571-272-3282, and the telephone number for the undersigned will change to 571-272-3225.



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